

Applicant: Wiethoff et al.
Application No.: 10/587,065

Remarks

Claims 1, 2, and 5 to 37 are pending in the application. A non-final rejection was entered on June 29, 2010. Applicants respectfully disagree with the rejections, and request that they be reconsidered and withdrawn in view of the following remarks.

Telephone Interview Request

In the event that the examiner maintains a rejection of any of the pending claims, the undersigned counsel for Applicants respectfully requests a telephone interview with the examiner to discuss the specific rejections, cited patent documents, and the claims.

Amendments

No amendments are made herein, and none is believed to be necessary.

Rejections Under 35 U.S.C. §103

Claims 1, 2, 5 to 24, and 34 to 37 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Oosterling et al.*, U.S. Patent 6,578,516 in view of *Maier, Jr.*, U.S. Patent 6,571,731. This rejection was made even though on April 23, 2010, Applicants amended the claims to recite that the object recognition rule is performed by a determination device. This device is not disclosed, taught or suggested by the art of record. Further, the recited steps are not performed by any device in the cited art.

Applicants' April 23, 2010 response stated the following about *Oosterling et al.* and *Maier, Jr.*:

Rather than repeating earlier arguments about *Oosterling et al.*, Applicants wish to address the action at page 8 where the examiner responds to Applicants' previous arguments that *Oosterling et al.* reference fails to teach an object recognition rule for distinguishing particles from non-particles other than by visual inspection. The examiner believes that during a visual inspection, any number of object recognition rules would be used to determine a presence of particles, and that a user merely viewing an image of the filter would be able to

use a rule to determine the color, shape, size etc. The examiner asserts that for this reason independent claim 1 does not distinguish itself from *Oosterling et al.*

Applicants also argued that the prior art does not teach a method of *automatically* determining the contamination or particulate in the sample, but the examiner asserts that this limitation is not positively recited in the present claims. To overcome this argument, Applicants now amend the claims to recite that steps are performed automatically by a determination device, for example. This amendment addresses the examiner's interpretation of the claims and distinguishes *Oosterling et al.*

In the latest action, the examiner does not appear to address these arguments directly. Instead, the action simply states that most of the claim elements are disclosed by *Oosterling et al.*, except for the detector and determination device. To fill these gaps, *Maier, Jr.* is cited as disclosing a detection device and a determination device to support a conclusion that it would have been obvious to a person skilled in this art to combine the two and arrive at the claimed invention.

Despite reaching this conclusion, the action fails to identify an object recognition rule in either patent. Instead, the action states, "When seen through a camera, *it* would have been able to tell the difference between a potential particle object and a bubble 'non-particle object' as claimed." (Action, page 2, third paragraph, emphasis added.) The flaw in this argument is that "it" is nothing more than a camera and would not be able to apply an object recognition rule. Further, the "it" is not specified to be a determination device that can process the object recognition rule. There does not appear to be a *prima facie* case of obviousness in the action, and there is nothing in the art of record that would support a *prima facie* case of obviousness. Therefore, independent claim 1 and all of its dependent claims would not have been obvious to one of ordinary skill in the art, and they are allowable.

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Conclusion

For the foregoing reasons, Applicants respectfully submit that the pending claims are allowable, and request that this case be passed to issue.

Respectfully submitted,


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